

REMARKS

Claims 24-25, 27-29 and 31-38 are pending.

Claim 24 has been amended, in part, according to Examiner's suggestion. The amendment does not introduce new matter.

Applicants respond to the issues raised by Examiner in the order in which presented in the office action.

§ 112 – New Matter

Examiner states that the newly added range of weight ratios are new matter because it is not seen to be taught in the specification as filed.

In response, it is pointed out that this wt-ratio limitation was derived from the originally disclosed amounts of the relevant components. It is accepted PTO practice that re-representing properties that are inherent in the disclosed invention is not new matter.

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, **even though it says nothing explicit concerning it**. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971).

MPEP § 2163.07(a) Inherent Function, Theory, or Advantage.

Accordingly, this basis for rejection should be withdrawn.

With respect the mono-/diglycerides neutralized with citric acid esters, this limitation has been deleted.

Obviousness-type Double Patenting

Examiner believes that the claimed subject matter is not patentably distinct over claim 8 of US 6428769.

It is respectfully requested that this provisional double patenting rejection be withdrawn, as the pending claims are clearly patentable over US769, claim 8. The generic reference to cosmetics and dermatological formulations in claim 8 of US769 does not specifically recite any limitation in the pending claims. Merely alleging that the the claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir.1994). MPEP 2144.08,

To establish a prima facie case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential to find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996)

There is no suggestion in claim 8 of US769 to provide the components recited in the instantly claimed compositions. A broad generic disclosure is insufficient. Therefore, the conclusion that claim 8 and the relevant claims presented herein are not patentably distinct is incorrect. In fact, US769- claim 8 would not even be sufficient to maintain a more typical rejection under § 103(a). See, In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994).

Further, the pending claims are drawn to removing sebum, i.e., an oily substance that accumulates on the skin. Removing this oily material would tend to make the skin more dry, not less. Thus, the instantly claimed method provides a result that is the exact opposite effect of that desired by US769-claim 8.

For these reasons, the provisional double patenting rejection should be withdrawn.

Obviousness over Sanchez in view of Lucas

A. Insufficient Motivation or Suggestion to Combine References

Examiner's proposed modification of Sanchez's composition using Lucas's disclosure is improper.

1. Lucas teaches cyclodextrin-containing compositions to remove odors derived from exogenous sources. Column 22 exemplifies this with examples of odors from cooking, cigarette smoke and gasoline. There is not a single piece of disclosure indicating that such a composition could be used to treat skin with excess sebum build up.

In Lucas's Detailed Description of the Invention in col. 2, lines 13-40, the purpose and use of the compositions are described as follows:

- The methods for controlling environmental malodors comprising the application of a [sic] if perfume-free, malodor-absorbing composition. Lines 13-15.
- The term "environmental malodors", as used herein means any odor which may be on a human or mammal which is not the result of human or mammalian body odor and/or body fluids. Such odors include but are not limited to odors from foods such as fish, garlic, onions, peppers and spices; cooking; smoke; tobacco; gasoline; and the like. Lines 22-28.
- The term "body fluids", as used herein, includes eccrine sweat, apocrine sweat, sebum, build up of sensible moisture from transepidermal water loss, vaginal discharge, urine, and mixtures thereof. The term "body odor", as used herein, means odors which are generated as a result of the natural functioning of a human or mammalian body. Lines 29-33.

Taken together, it is clear that Lucas does not teach or suggest that this composition may be used to remove sebum and/or cerumen from the skin, let alone inhibit sebum production.

For this reason, the rejection should be withdrawn.

3. Another basis that Examiner seems to rely on is the apparent lack of technological sophistication that may be required to convert Sanchez's composition into an emulsion-type of mixture. However, this is not a proper rationale. See MPEP § 2143.01 – The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir.1999).

Put another way, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), MPEP § 2143.01.

The fact that Lucas teaches cyclodextrin compositions in the form of emulsions, is not sufficient to motivate persons of ordinary skill in the art to modify Sanchez's. This conclusion is not altered by any presumed expectation that the physical making of Examiner's proposed modification may be within the technical grasp of persons of ordinary skill. These two references teach fundamentally distinct compositions that are used for clearly distinct purposes.

It is respectfully requested that in view of the foregoing amendments and remarks, that all rejections under §§ 103 and 112, be withdrawn, and allowance be granted.

Examiner has not made out a *prima facie* case of obviousness because she has not provided sufficient motivation or suggestion that would reasonably be expected to guide persons of ordinary skill in the art to modify Sanchez's aqueous cyclodextrin cerumen-removing compositions by converting it into an emulsion-type composition that removes environmental odor-causing material.

Examiner has relied on Sanchez's generic disclosure of his compositions having up to 10% solvents, organics, etc., col. 5, lines 12-21. However, there is not a single example of such a composition exemplified. Neither is there even one specific example of one specific hydrophobic or lipophilic component, surfactant or emulsifier disclosed. Examiner concludes that Sanchez's disclosure broadly encompasses the oily components recited in the claims. However, in raising this rejection, Examiner is apparently concluding that this means that any oily component will suffice. There is no evidence of record to support this conclusion.

Based on Sanchez's and Lucas's disclosure, it is respectfully requested that Examiner provide a rationale, given Lucas's disclosure of perhaps millions of combinations of oily components, how did Examiner choose which components to combine with Sanchez to form this rejection?

Based on the facts of record, the rejection is at most, based on an obvious to try rationale, which is known to be insufficient for maintaining § 103(a) rejections.

2. A most likely rationale for maintaining the § 103(a) rejection is that Examiner has used Applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art. This use of hindsight is clearly improper in maintaining an obviousness rejection. See, e.g., Grain Processing Corp. v. American Maize-Prods., 5 USPQ 2d, 1788, 1792 (Fed. Cir.1988); MPEP § 2141- Basic considerations.

Absent Applicant's disclosure, persons of ordinary skill in the art would not have combined Sanchez and Lucas as the Examiner asserts.

CONDITIONAL PETITION FOR EXTENSION OF TIME

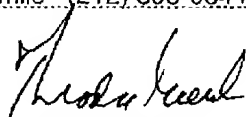
If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

Respectfully Submitted,

Norris, McLaughlin & Marcus
220 East 42 nd Street
New York, NY 10017
Telephone (212) 808-0700
Facsimile (212) 808-0844


Theodore Gottlieb, PhD
Reg. No. 42, 597

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